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In re Application of
GALLI et al.
Application No.: 09/647,939
PCT No.: PCT/EP99/02624
Int. Filing Date: 19 April 1999
Priority Date: 20 April 1998
Attorney Docket No.: P66004US0
For: SOURCE OF NUCLEI FOR NUCLEAR
TRANSFER

DECISION

This communication is in response to applicants' "PETITION UNDER 37 C.F.R. 1.182" filed 14 March 2002. The petition fee of \$130 has been paid.

BACKGROUND

On 19 April 1999, applicants filed international application PCT/EP99/02624, which claimed a priority date of 20 April 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 28 October 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 19 November 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 20 October 2000.

On 18 October 2000, applicants filed a TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee of \$860 and the surcharge under 37 CFR 1.492(e) of \$130 for filing the oath or declaration later than thirty months from the priority date; an authorization to charge any additional fees set forth in 37 CFR 1.492 to Deposit Account No. 06-1358; and a preliminary amendment. These application papers were identified by applicants with attorney docket number P66004US0 and were assigned application number 09/647,939.

On 20 October 2000, applicants filed a second TRANSMITTAL LETTER (FORM PTO-1390) for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee of \$860 and the surcharge under 37 CFR 1.492(e) of \$130 for filing the oath or declaration later than thirty months from the priority date; an authorization to charge any additional fees set forth in 37 CFR 1.492 to Deposit Account No. 06-1358; and a preliminary

amendment. These application papers were identified by applicants with attorney docket number P64474US0 and were assigned application number 09/673,236.

On 06 November 2000, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form DO/EO/905) for application number 09/647,939 indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required.

On 17 November 2000, applicants submitted a "REQUEST FOR REFUND AND WITHDRAWAL OF APPLICATION" stating that through inadvertent error and mistake, application number 09/647,939 and application number 09/673,236 were identical. Applicants stated that "[i]nsofar as Serial No. 09/647,939 is concerned, this application is herewith expressly withdrawn as being a duplicate of U.S. Serial No. 09/673,236" and requested that the payment of \$990 made on 18 October 2000 be refunded.

On 29 November 2000, the USPTO mailed NOTICE OF CANCELLATION OF ASSIGNED SERIAL NUMBER (Form PCT/DO/EO/908) in application number 09/647,939 indicating that the assigned serial number 09/673,236 has been cancelled. This Notice indicated that the transmittal letter filed 20 October 2000 identified itself as a first submission of items concerning a filing under 35 U.S.C. 371 and was incorrectly assigned a new serial number. The Notice also indicated that assigned serial number 09/647,939 should be used when filing papers in the USPTO.

On 31 May 2001, the USPTO charged Deposit Account No. 06-1358 a \$270 multiple dependent claim fee for application number 09/647,939.

On 01 June 2001, the USPTO mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that application number 09/647,939 was abandoned for failure to respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 06 November 2000.

On 16 July 2001, applicants submitted a "SECOND REQUEST FOR REFUND" requesting that Deposit Account 06-1358 be refunded the \$990 paid on 18 October 2000 because that application was "withdrawn" and the \$270 charged to Deposit Account No. 06-1358 on 31 May 2001 because this application was "withdrawn" and because a preliminary amendment was filed on 18 October 2001 cancelling the multiple dependency.

On 26 February 2002, the USPTO mailed a NOTIFICATION indicating, *inter alia*, that all of the papers filed on 20 October 2000 have been placed in application number 09/647,939, that the submission filed 18 October 2000 and the submission filed 20 October 2000 have been placed in the file of application number 09/647,939, and application number 09/647,939 remains abandoned for the reasons set forth in the NOTIFICATION OF ABANDONMENT mailed 01 June 2001.

On 14 March 2002, applicants filed the instant "PETITION UNDER 37 C.F.R. 1.182". The requisite petition fee has been paid.

DISCUSSION

Applicants request that the following documents which were filed in the '236 application rather than the '939 application now be accepted in the '939 application: Request for Refund and Small Entity Declaration filed 20 December 2000; a Transmittal of Missing Requirements Under 35 U.S.C. 371 filed 20 December 2000; an IDS filed 23 January 2001; and a Preliminary Amendment filed 16 March 2001. Copies of date-stamped postcard receipts for these items also accompany the petition.

Copies of the documents listed above do not appear in the '939 application. The request to treat these documents as having been received in the USPTO on the dates indicated above is treated as a petition under 37 CFR 1.181. The request to have these documents accepted in the '939 application is treated as a petition under 37 CFR 1.182.

Petition Under 37 CFR 1.181

Applicant has provided sufficient evidence to establish that applicant filed the documents indicated above on the dates indicated above. The proof is in the form of copies of the postcard receipts for the above-identified documents which bear a United States Patent and Trademark Office date stamp and which itemize the documents identified above and identify the application number, attorney docket number, and applicant. Further, practitioner states that the copy of the papers filed 14 March 2002 are true copies of the papers originally filed. Therefore, in view of the postcard receipts and practitioner's statement, the documents indicated above received on 14 March 2002 may properly be accepted as originally received in the USPTO on the dates indicated above.

Petition Under 37 CFR 1.182

Although the documents indicated above were directed to the '236 application, on petition, the acceptance of these documents as having been received in the '939 application is appropriate. Accordingly, on petition, the Request for Refund and Small Entity Declaration may be given a 20 December 2000 receipt date; the Transmittal of Missing Requirements Under 35 U.S.C. 371 may be given a 20 December 2000 receipt date; the IDS may be given a 23 January 2001 receipt date; and the preliminary amendment may be given a 16 March 2001 receipt date.

The Transmittal of Missing Requirements Under 35 U.S.C. 371 filed 20 December 2000 included a declaration of inventors. The declaration of inventors is in compliance with 37 CFR 1.497(a)-(b). Accordingly, the NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) mailed on 01 June 2001 indicating that application number 09/647,939 was

abandoned for failure to respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 06 November 2000 is hereby VACATED. It is noted that the assignment document filed with the Transmittal of Missing Requirements Under 35 U.S.C. 371 for application number 09/673,236 will not be re-recorded. Applicant must submit a new assignment document for application number 09/647,939.

As to the Request for Refund and Small Entity Declaration filed 20 December 2000, a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under 37 CFR 1.27(c) and a request for a refund of the excess amount are filed within three months of the date of the timely payment of the full fee. 37 CFR 1.28(a). Here, an assertion of small entity status under 37 CFR 1.27(c) and a request for refund of the excess amount have been filed within three months of the timely payment of the full fee. Accordingly, Deposit Account 06-1358 will be credited \$495. It is noted that the Notification mailed 26 February 2002 indicated that the \$270 multiple dependent claim fee charged to Deposit Account 06-1358 on 31 May 2001 would be credited to that account since the preliminary amendment filed 18 October 2000 removed any multiple dependent claims. The \$270 was credited to applicant's deposit account on 28 February 2002. However, that portion of the Notification overlooked the multiple dependency that still existed in claim 9 even after the preliminary amendment of 18 October 2000 was entered. The application will be reviewed for all fees which may need to be debited or credited after the above-indicated documents have been entered.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is GRANTED.

For the reasons set forth above, the petition under 37 CFR 1.182 is GRANTED.

For the reasons set forth above, the NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) mailed on 01 June 2001 is VACATED.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including: (1) entry of the following documents (which are incorrectly identified by application number 09/673,236): Transmittal of Missing Requirements Under 35 U.S.C. 371 filed 20 December 2000; Transmittal of Small Entity Declaration and Request for Refund filed 20 December 2000; Information

Disclosure Statement filed 23 January 2001; and the Preliminary Amendment filed 16 March 2001; (2) review of the application fees for any charges which need to be credited or debited; (3) according the application a 35 U.S.C. 371(c) date of **20 December 2000**.


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